

Patent Docket P1819R1

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B. Webb
1/12/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of David G. Lowe et al. Serial No.: 09/823,648 Filed: 30 March 2001 For: COMPOSITIONS AND METHODS FOR DETECTING AND QUANTIFYING GENE EXPRESSION	Group Art Unit: 1655 Examiner: Arun K. Chakrabarti
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December 20, 2001	
 Ann Savelli	

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This document is timely submitted in response to an Election Requirement mailed December 5, 2001 for which a one-month period for response was given, making the document due on or before January 5, 2002. In view of the discussion provided, reconsideration and allowance are respectfully requested.

Restriction Requirement

Pending claims 1-104 were restriction into the following groups under 35 U.S.C. § 121:

- I. Claims 1-40, drawn to microarray of nucleic acids, classified in class 536, subclass 22.1+.
- II. Claims 41-51, drawn to activated slides, classified in class 502, subclass 180+.

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- III. Claims 52-54, drawn to method of activation of slides, classified in class 585, subclass 906+.
- IV. Claims 55-83, drawn to method of making microarray, classified in class 536, subclass 25.3.
- V. Claims 84-104, drawn to method of nucleic acids hybridization, classified in class 435, subclass 6.

The Examiner reasons that Groups I, II, and III are unrelated; Groups II, IV, and V are unrelated; Groups III, IV, and V are unrelated; and Groups IV and V are unrelated as not disclosed as capable of use together and have different modes of operation, different functions, or different effects. Applicants respectfully traverse the rejection because a search of the literature with respect to these claims can be performed by the Examiner without undue burden, thereby making the restriction improper. In addition, Applicants respectfully point out that in paragraph 6, page 4, of the Office Action, the Examiner's statement suggesting that Groups II and IV are not disclosed as capable of use together is incorrect. In fact, claim 55 of Group IV (method of making a microarray) recites an activated slide (such as that of claim 41, Group IV) in the method. Thus, the inventions of Groups II and IV are not distinct because they can be used together.

The Examiner also reasons that Groups I & IV and Groups II & III are related as process of making and product made, but that the claims of the related groups are distinct because, for example, the products can be made by other processes.

Finally, the Examiner states that the inventions of Groups I and V are related as product and process of use, but are distinct. Applicants respectfully point out that the reason given for the distinction is incorrect. Contrary to the Examiner's statement at page 3, paragraph 4, lines 6-7, the method of nucleic acids hybridization of Group V does not produce RNA and protein or produce antisense nucleic acid for gene therapy. The method is for analyzing a target molecule attached to a

microarray (see claim 84). Thus, because the reason given for the distinction is incorrect, the restriction requirement of Groups I and V should be withdrawn.

In summary, the restriction requirement is respectfully traversed as incorrect or because the subject matter can readily be searched together without undue burden on the Examiner. Withdrawal of the restriction requirement is respectfully requested.

In the event that the restriction requirement is not withdrawn and merely to advance prosecution and allowance of claimed subject matter, Applicants elect Group I, claims 1-40, drawn to a microarray of nucleic acids.

If the Examiner has any questions, the Examiner should feel free to call the undersigned attorney at the number indicated below.

This document is timely filed within the one-month period for response. Applicant believes that no fees are due with this submission. In the unlikely event that fees are due, Applicant hereby petitions the Commissioner to authorize any extensions of time and/or to deduct fees or add credits due to our Deposit Account 07-0630 as necessary to maintain the pendency of this application.

Respectfully submitted,
GENENTECH, INC.

Date: December 20, 2001

By: 
Deirdre L. Conley
Reg. No. 36,487
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PATENT TRADEMARK OFFICE
Doc. # 102094

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Ann Savelli

Type or print name of person signing certification

Signature Ann SavelliDate: 12/20/01

DATE: December 20, 2001

Please deliver the following page(s) to:

NAME: **Examiner Arun Chakrabarti, Group Art 1655**
U.S. Patent and Trademark Office
Washington, DC 20231

Fax No.: 1-703-305-7401

FROM: Deirdre L. Conley
Registration No.: 36,487

RE: U.S. Serial No.: 09/823,648
Our Docket No.: P1819R1

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Number of Pages including this cover sheet - 7

Response to Restriction Requirement - 3 pages
Request to Correct Inventorship - 2 pages (original and copy)
Transmittal Letter - 1 page

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<p>CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this correspondence is being facsimile transmitted to the US Patent Office, Group Art 1655, 703-306- 7401 on December 20, 2001.</p> <p><i>Arun K. Chakrabarti</i> Arun K. Chakrabarti</p>	

TRANSMITTAL LETTER

**Assistant Commissioner of Patents
Washington, D.C. 20231**

Sir:

Transmitted herewith are the following documents:

1. Response to Restriction Requirement
 2. Request to Correct Inventorship (dup)

In the event any additional fees are due in connection with the filing of these documents, the Commissioner is authorized to charge such fees to our Deposit Account No. 07-0630.

Respectfully submitted,

GENENTECH, INC.

By: 
Deirdre L. Conley
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